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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,188	03/29/2001	John Greeven	10004662-1	1218

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,188

Applicant(s)

GREEVEN ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-39 and 48-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-39 and 48-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/24/03 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the network is being coupled to and where the information is coming from, as the group indicated by the preceding words "derived from at least one of..." in the last line indicates a group, but the group includes patient monitors and appliance diagnostic status. These two items appear to be unrelated for such a grouping. In addition, it is not certain which appliance is being referred to.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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((e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 22-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Liff (6,471,089 B2). Liff discloses the drug dispensing system as follows.

As described in Claims 22, 31, 32, 36, 53 and 54;

1. a controller (314);
2. a reservoir of pharmaceutical (20) ***specific to an individual and to be dispensed over time to a patient, the pharmaceutical including at least one of tablets, liquids or gases, to be administered to a patient in individual or discrete doses according to a treatment regimen;*** (See col. 1, last line and col. 2, lines 1-7 for "dispensing a pharmaceutical over time" and col. 8, lines 16-20 for liquid and other forms of drugs being dispensed. See also col. 2, lines 52-54 which indicate that each bottle contains a certain number of doses, which can be construed as including one dose or a several doses. *Note that the reservoir can be construed as being specific to an individual, such as a doctor in a hospital or nurse, who can either administer/manage the dispensing or who might outright own the dispenser. Note also that an individual may be construed to be an institution such as a pharmacy, research center or a hospital.*)

3. a drug delivery mechanism ***located proximate to the patient at a location remote to a hospital*** (see figures 5-6c); (Note that the drug delivery mechanism may be construed to be located proximate to a patient in a hospital if that patient's room is located across from the dispenser for the entire hospital. Note also that locating such a dispenser in all hospital rooms could be construed to be no different than locating them across the hall or down the hall, at the other end of the floor. The limitations "proximate to the patient remote to a hospital" can be construed in a reasonably broad sense to even include locating a dispenser, such as Liff's element (20), at a bedside of a patient located ***at their home***. If the home is located next door to the hospital, it can be construed as remote from the hospital. Note further, that such limitations as "***located proximate to the patient at a location remote to a hospital***" are seen as arbitrary to the function of the system, and that for all practical purposes, Applicant's claimed system functions as Liff's system does.)

4. a data network interface coupled to said controller (see figure 13a);

As described in Claims 23, 24, 31-34, 37, 38 and 39;

5. sending messages to and from a health care service provider or drug supplier (see figure 14T, for example, noting payors, doctors, inventory and refills have files for information pertaining thereto),

6. said data message identifying the patient and the identity of the particular drug (see figure 14K, for example);

7. dispensing the pharmaceutical to the patient from the reservoir in a precise amount in response to signals from said controller; (Note that the dispenser dispenses drugs in a wide variety of forms, such as bottles or containers of pills, based upon signals from a controller, cited above.)

As described in Claims 25 and 55;

7. a human/display interface *including at least one of a tactile input device or a speech recognition device operatively coupled to the controller* (see figures 14A-14T, and 16, noting that laptop computers (566) and workstation (555) inherently have, at the very least, either a keyboard or a touchscreen—note also pen computers (558 and 568), which use a pen for input);

As described in Claims 26, 27, 35 and 58;

8. effecting payment for the provision of health care service or for a drug (see col. 18, lines 4-17);

As described in Claim 28;

9. the message is transported over the internet (see figure 18);

As described in Claim 29;

10. the message is transported via wireless (see col. 8, line 24;

As described in Claims 30 and 57;

11. a pharmaceutical level detector (182), see figure 7c;
12. the pharmaceutical level detector configured to ascertain at least one of measured weight of pharmaceutical remaining in the reservoir,

decremented amount remaining in the reservoir, depth of measurement of pharmaceutical in the reservoir, and static pressure within the reservoir (note that the level detector (182) detects the level of the inventor remaining in a reservoir, noting that "the reservoir" can be reasonably broadly construed as being either a single dispensing device or several dispensing devices, and that such a level of inventory is construed as being a decremented amount, as the bottles of drugs are discrete items);

As described in Claim 48;

13. the pharmaceutical is at least one liquid material; (See col. 8, lines 16-20.)

As described in Claim 50;

15. the controller includes a memory device contained within the appliance (see Claim 30 of Liff et al, which states that a memory is connected to the system computer);

As described in Claim 51;

16. the memory device contains at least one treatment regimen regulating dispensing of individual doses of pharmaceutical to the patient; (see Claim 30 of Liff et al, which further states that the memory stores patient data and drug interaction data. See also col. 18, lines 42-65.)

6. Claims 53 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Shusterman (US 6,471,087 B1). Shusterman discloses Applicant's claimed system as follows.

As described in Claim 53;

- 16a. a controller (800) (See figure 8);
- 16b. a reservoir of pharmaceutical specific to the individual patient to be dispensed over time (see col. 2, lines 23-36);
- 16c. a drug dispensing mechanism (212), located proximate the patient at a location remote to a hospital, the drug delivery mechanism coupled to, and responsive to, the controller and to the reservoir to dispense the pharmaceutical to the patient from the reservoir in a precise amount in response to signals from said controller (again, note col. 2, lines 25-27, which indicates that a precise dose of medication is stored in each compartment for dispensing);
- 16d. a data network interface (400) coupled to said controller (see col. 4, lines 10-14);

As described in Claim 56;

- 16e. at least one sensor (216, 218) operatively coupled to the controller, the sensor capable of providing data signals indicative of the patient's physical condition (see also figures 4b, 5, 6, 7);

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al in view of Monkhouse et al (US 6,514,518 B2). Liff et al discloses the drug dispensing system as described above. Liff et al does not expressly disclose, but Monkhouse discloses the following.

As described in Claim 49;

14. the drug delivery mechanism includes an ink-jet print head (22),
(see col. 3, lines 6-57) capable of delivering precise amounts of the liquid
(note that the "binder" is a liquid binder—see col. 5, lines 45-49);

At the time of the invention, it would have been obvious to one ordinarily skilled in the art to have coupled the ink jet printer drug dispensing device of Monkhouse et al to the networked system of Liff et al.

The suggestion/motivation would have been to provide drugs in a 3DP format, which provides a "multiphasic dosage form capable of providing delivery of multiple drugs having different release characteristics." See col. 2, lines 25-29 and col. 3, lines 5-17 of Monkhouse et al. See also Liff et al, abstract, noting that the system controls dispensing of drugs from dispensers and that it would be obvious to one of ordinary skill

in the art to provide dispensers attached to Liff's system that would dispense drugs in a standard format adopted by the medical community. 3DP format dosages are just such a format.

Therefore, it would have been obvious to combine Liff et al with Monkhouse et al in order to obtain the invention as described in Claim 49.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al in view of O'Brien (US 5,963,136). Liff et al discloses the drug dispensing system as described above. Liff et al does not expressly disclose, but O'Brien discloses the following.

As described in Claim 52;

17. wherein the data network interface (see figure 3, for example, noting that the system of O'Brien is a networked system—see also col. 8, lines 19-24) is adapted to be removably coupled to (note that it would have been expedient for one ordinarily skilled in the art to provide a coupling that is readily removable, such as a plug or computer cable with standard couplings, which are designed to be readily removable) and receive information derived from at least one patient monitoring sensor (see col. 5, lines 42-59, for example describing a temperature sensor), such information being an appliance diagnostic status (note col. 5, lines 56-59 describe monitoring an electro cardiogram, which can be construed

as an appliance, the status of which would consist of the electronic output of the monitor, since the purpose of the EKG monitor is to provide diagnostic status of the patient, not necessarily the diagnostic status of the monitor itself);

At the time of the invention, it would have been obvious to one ordinarily skilled in the art to have coupled the networked prescription compliance system of O'Brien et al to the system of Liff et al.

The suggestion/motivation would have been to provide "interactive prescription compliance." See abstract of O'Brien et al. See also Liff et al, abstract, noting that the system controls dispensing of drugs from dispensers in order to fill patient prescriptions and that it would be obvious to one of ordinary skill in the art to provide a prescription compliance capability to Liff's system, since patient compliance with a prescribed regimen of drugs is considered by the medical community to be a major goal in providing effective patient medical treatment.

Therefore, it would have been obvious to combine Liff et al with O'Brien in order to obtain the invention as described in Claim 49.

Response to Arguments

9. Applicant's arguments filed 9/24/03 have been fully considered but they are not persuasive. Liff et al appears to anticipate Applicant's independent claims. Liff, as described above, discloses an intelligent drug dispensing system, construed as intelligent since the system of Liff is computer controlled, comprising drug dispensers,

having a reservoir, or inventory, of drugs, such drugs being of a variety of types, the system being network-based. *The new limitations of the amendment to the independent claims appear to be sufficiently broad to allow one to reasonably construe the system of Liff et al as reading on Applicant's claimed system.*

Further, Applicant's new claims 53 and 56 appear to read on the system of Shusterman, as described above. Therefore, as the claims read on the prior art, the rejection of Claims 22-39 and 48-58 is maintained.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Simonsen et al (US 6,540,672 B1) is cited as disclosing a remotely controlled monitor which senses a patient's condition.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

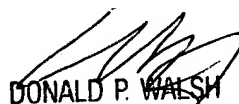
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Jeffrey A. Shapiro
Examiner
Art Unit 3653

October 27, 2003



DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600